ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Applicant notes that the Examiner has failed to indicate whether the drawings are acceptable.

Claims 1-25 remain in this application. New claims 26-29 are added without adding any new matter.

Claims 1, 3, 7-10, and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by Beck *et al.* (U.S. App. No. 2004/0057591 A1). Claims 2, 4-6, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beck in view of Gabara *et al.* (U.S. 7,024,000 B1). Claim 13 was rejected 35 U.S.C. §103(a) as being unpatentable over Beck in view of Bye *et al.* (U.S. 2004/0204921 A1). Claims 14-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Beck in view of Bye and Kates (U.S. Pat. App. 2002/0176584 A1). For the following reasons, the rejections are respectfully traversed.

Claim 1 recited a method for adjusting a first hearing device based on adjustments of a second hearing device, the method including the step of "converting an acoustic signal *generated by a receiver* of the second hearing device into an electrical signal". The Examiner cites item 8 of figure 1, and paragraph 0057 as teaching such a feature. However, there is no teaching of any converting of an acoustic signal generated by the receiver of either of items 8 and 8', which are identified as being transmission and reception units, into any electrical signal. Instead, the units 8 and 8' appear to receive an electrical signal from items 5 and 5', respectively, and also appear to output some type of electrical signal 10. Note that the signal from microphone 2 is *not* a signal generated by any receiver. Thus, there is no conversion of any acoustical signal generated by a receiver into an electrical signal, and thus claim 1 is patentable over the reference.

Claim 14 recites an apparatus where an "acoustic test signal is fed to a microphone of [a] second hearing device in which *another acoustic signal* is generated that is recorded by [a] measurement microphone of [a] *couple element*, the measurement microphone being operatively connected to [a] first hearing device which is operatively connected to the control unit." The Examiner admits that there is no teaching in Beck of any "couple element" for recording *another* acoustic signal, and being operatively connected to another hearing device. Accordingly, the Examiner cites the measurement microphone of Kates as disclosing such a coupling element. However, the measuring microphone 118 found in Kates does not connect to another hearing device, but instead connects to a computer 104. Bye fails to overcome this shortcoming, and thus claim 14 is patentable over the references.

Similarly, claim 20 recites an apparatus where "a receiver of [a] first hearing device is coupled to [a] microphone of [a] second hearing device by [a] further couple element and [a] receiver of the second hearing device is coupled to [a] measurement microphone of the couple element, the measurement microphone being operatively connected to the second hearing device". Again, there is no teaching in any of the references of a coupling element that connects one hearing device to another hearing device, and thus claim 20 is also patentable over the references.

New claim 29 has limitations similar to those discussed above, and thus is patentable over the references for similar reasons. Finally, the remaining claims depend, directly or indirectly, upon one of the above discussed claims, and thus are patentable over the references for at least the same reasons as their parent claims.

Finally, the Examiner has failed to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles

practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36321.

Respectfully submitted,
PEARNE & GORDON, LLP

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By: /Robert F. Bodi/
Robert F. Bodi, Reg. No. 48,540

1801 East Ninth Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700